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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/961,238

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Kevin McCarthy

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5762

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7590

09/29/2004

ANTONELLI, TERRY, STOUT & KRAUS, LLP  
1300 NORTH SEVENTEENTH STREET  
SUITE 1800  
ARLINGTON, VA 22209-9889

EXAMINER

ENG, GEORGE

ART UNIT

PAPER NUMBER

2643

3

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/961,238

**Applicant(s)**

MCCARTHY ET AL.

**Examiner**

George Eng

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 2/21/2003 (paper no. 2) has been considered.

### ***Response to Preliminary Amendment***

2. This Office action is in response to the preliminary amendment filed 11/17/2001.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6-11, 13 and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Holmstrom et al. (US PAT. 6,198,939 hereinafter Holmstrom).

Regarding claim 1, Holmstrom discloses a communication terminal (10, figure 1) having a function for searching available menu items of said communication terminal, the function comprising a processing means controlling the communication terminal and a user interface through which the user communicates with the processing means, wherein the processing means requests the user to enter search criteria when the user requested a menu item access, analyzes

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the search criteria when the user indicates that the search criteria input has been finalized, and presents a list of menu items matching the entered search criteria, thereby enabling the user to scroll through the presented list of matching menu items and to select the menu item for being executed by the processing means (col. 3 line 50 through col. 5 line 67).

Regarding claims 2-4, Holmstrom discloses to present user input, i.e., characters, in a dialog box on the communication terminal via a keypad (col. 6 lines 8-13).

Regarding claim 6, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claims 7-8, Holmstrom teaches to arrange the functions in all menu alphabetically to be search and access from one menu (col. 6 lines 28-49).

Regarding claim 9, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claims 10-11, the limitations of the claims are rejected as the same reasons set forth in claims 7-8.

Regarding claim 13, Holmstrom discloses that the finalization of the user input can be made by the user that presses a key on the communication terminal (col. 4 lines 27-44).

Regarding claims 15-16, the limitations of the claims are rejected as the same reasons set forth in claim 4.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 5, 14 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmstrom et al. (US PAT. 6,198,939 hereinafter Holmstrom) in view of Pisutha-Arnond et al. (GB 2345227 hereinafter Pisutha-Arnond).

Regarding claim 5, Holmstrom differs from the claimed invention in not specifically teaching the input to the processing means being made via voice input. However, it is old and notoriously well known in the art of inputting requests to a processor of a communication terminal via voice input, in order to make user friendly by providing efficient entry of information, for example see Pisutha-Arnond (page 28 lines 3-13). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Holmstrom in having the input to the processing means being made via voice input, as per teaching of Pisutha-Arnond, because it makes friendly by providing efficient entry of information.

Regarding claims 14 and 17-19, the limitations of the claims are rejected as the same reasons set forth in claim 5.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmstrom et al. (US PAT. 6,198,939 hereinafter Holmstrom) in view of Sudo et al. (US PAT. 5,987,336 hereinafter Sudo).

Regarding claim 12, Holmstrom differs from the claimed invention in not specifically teaching a timer to make the finalization of the user input. However, Sudo teaches to utilize a timer to count or measure the elapsed time from user input, and to return to an initial screen, i.e., to make the finalization of the user input, when no operation is operated for a specified length, thereby preventing erroneous operations (col. 12 lines 19-57 and col. 13 line 4-21). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Holmstrom in making the finalization of the user input by the timer, as per teaching of Sudo, in order to prevent erroneous operations.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cushman et al. (US PAT. 6,125,287) discloses a wireless telephone having an improved user interface (abstract). Anderson et al. (US PAT. 5,737,394) discloses a portable telephone apparatus having a plurality of selectable functions activated by the use of dedicated soft keys (col. 2 lines 3-67). Will (US PAT. 5,825,353) discloses a method of control a handheld

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miniature personal digital assistant based on a user interface with menu and thumbwheel (abstract).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tue-Fri 7:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



George Eng  
Primary Examiner  
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